

REMARKS/ARGUMENTS

Drawings

The documents submitted by the Examining Attorney show no objection to the drawings. Therefore, Applicant hereby requests that the drawings herein be approved and accepted as filed.

Obviousness - Section 103(a) Rejection

Preliminarily, the Applicant affirms to the Examiner that the claims and subject matter thereof were commonly owned at the time any inventions covered therein were made.

Section 103(a) Rejection

The Examiner states that claims 1-10 and 12 remain rejected and claims 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones '353, in view of the "realtor.com" reference and the Sutcliffe '216 reference. Applicant states that claim 12 was canceled in the Response to Office Action dated October 21, 1999. Applicant respectfully requests that the Examiner reconsider the rejection based on the points, authorities and argument set forth below.

Preliminarily, the claims have been amended primarily in response to the examiner's comments about the nature of the use of the term "affiliate". For

some aspects of this invention, the affiliates are independent from the computer system in which the method is practiced, meaning the affiliates are not the owners or operators of the computer system (such as realtor.com in that reference, or the service bureau in the Jones reference), but instead may be the real estate agents listing real property and rental/lease property; resorts; property managers; sellers of vehicles; hotel owners; travel agents; travel promoters; chambers of commerce; visitors bureaus; and others, mentioned in the specification, all of whom are independent of the computer system. In the Jones reference, if a service bureau for instance is involved, it is the intermediary between the two and the operator or owner of the computer system (the entity directly inputting the data for use by the virtual tour). The golf course and/or the user of the system for example are independent from the computer system.

This invention as set forth in the amended claims is not obvious for at least the following reasons:

The Applicant believes the Examiner is reading more into the references than is actually present. With respect to the realtor.com reference, the examiner asserts (at page 6) that realtor.com teaches receiving at least one still photograph such that the still photograph is available to be included in the virtual tour, referring to page 8 of the realtor.com reference. At that time, it is believed that while photographs and data could be emailed or electronically transmitted to realtor.com the realtor.com personnel were still required to take the photograph(s) and data and they would then have to perform the additional step

of formatting it and inputting it into a memory area so it could then be accessed by someone (a user) searching for a home to buy. This is consistent with the realtor.com reference cited by the Examiner.

The same is true for the Jones reference. In Jones, there is a service bureau that controls the computer system, and the service bureau receives raw data and has to engage in the additional step of formatting or relocating the data and/or photograph into the template it controls. The Examiner has not provided any reference in Jones to indicate anything other than this. The Jones reference is therefore insufficient to disclose what is claimed in this case, that is an ~~affiliate-independent-from-the computer system able to access a template to~~ directly input the photograph and/or data into the template for access by persons (users) looking for a house.

Therefore in both the Jones reference and the realtor.com reference, there is no direct input as required for instance by claim 1, but instead Jones and realtor.com require the additional step of handling by someone in control of the computer system to make it available to be retrieved by the virtual tour template.

There is nothing the Examiner has pointed out that indicates the photograph or data as transmitted by the golf course in Jones, or by the home owner in realtor.com, is stored in a location where it is available to be accessed by the virtual tour template, or that it is in fact used from that location.

There is nothing in any of the three references which teach, disclose or suggest the desirability of the combination and therefore the Examiner has not met the minimum required showing for *prima facie* obviousness.

The teachings of the Jones and the realtor.com references are not sufficient to render the claims *prima facie* obvious, because as stated above, it would change the basic operation of each. Both are set up to have the person or entity controlling the computer system receive the data or photographs from someone independent of the computer system, and then formatting or inputting the data or photograph into the virtual tour. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

Additionally and as stated before, the Examiner has misconstrued the Jones '353 reference, particularly in asserting that the affiliates input photographs and a data set into a template. In Jones, the cited references (col. 3, lines 12-22; and col. 21, lines 37) make it clear that the service bureau publishes the tours which conform to their format. There is not an independent affiliate entry of data directly into the template, but instead it is transmitted to the service bureau (by mail or electronically) for the service bureau to then input into the template and create it themselves. This invention on the other hand would allow the user/affiliates to directly input the photographs and data set into the template instead of transmitting the data for the service bureau to input and

create the virtual tour. Figure 5 of Jones '353 shows that the raw data 112 must be sent to an engineer for entry into the database 63, whereas in the applicant's claims, the data is input directly into the template and system without the need for the engineer.

The realtor.com reference does not provide the initial entry template for the affiliate to input the photographs or data set directly, as stated above.

There is no teaching in either Jones or the realtor.com reference, or suggestion to combine with Sutcliffe '216, and none has been referenced by the Examiner.

In the U.S. Court of Appeals for the Federal Circuit case of *In-Re: Lee*, 61 U.S.P.Q. 2d 1430, decided January 18, 2002, the Federal Circuit held:

... Thus, when they rely on what they assert to be general knowledge to negate patentability, that knowledge must be articulated and placed on the record. The failure to do so is not consistent with either effective administrative procedure or effective judicial review. The Board cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies.

The examining attorney has therefore failed to meet the requirement to set forth with specificity the general knowledge in the art to enable a finding that the person having ordinary skill in the art would make such combination.

As the PTO recognizes in MPEP 2142:

The legal concept of *prima facie* obviousness is a procedural tool of examination which applies broadly to all arts. It allocates who has the burden of going forward with production of evidence in each step of the examination process.... The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the Applicant is under no obligation to submit evidence of non-obviousness.... The initial evaluation of *prima facie* obviousness thus relieves both the Examiner and Applicant from evaluating evidence beyond the prior art and the evidence in the specification as filed until the art has been shown to suggest the claimed invention.

MPEP 2143.01 provides:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re: Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

The Federal Circuit has several times expressly addressed the issue of how to evaluate an alleged case of *prima facie* obviousness to determine whether it has been properly made. Thus, *In re: Geiger* stated in holding that the PTO "failed to establish a *prima facie* case of obviousness:

Obviousness cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. *ADC Hospital Systems, Inc. V. Monteffore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

The arguments submitted above apply to independent claims 1, 6, 8 and 9, and the claims which depend upon them are likewise patentable over the art for the same reasons and arguments.

Reply to Examiner's Response Argument

The Examiner responds to Applicants argument asserting that the features are not recited in the claims, a broad interpretation of the term "affiliate" and arguing that one cannot show non-obviousness by attacking references individually where the rejections are based on combinations of references.

First of all, the Applicant would like to clarify its prior response to be pointing out that the examiner does not have a *prima facie* case of obviousness because the combination does not include each element in the claims. MPEP 2142 states in relevant part: ". . . THE PRIOR ART REFERENCE (OR

REFERENCES WHEN COMBINED) MUST TEACH OR SUGGEST ALL THE CLAIM LIMITATIONS.” If the combination does not include each element in the claims, the law is very clear it is insufficient and does not establish the required prima facie case.

As the PTO recognizes in MPEP 2142: If the Examiner does not produce a prima facie case, the Applicant is under no obligation to submit evidence of non-obviousness....

The arguments above apply to each of the independent claims, and therefore to the claims upon which they depend, and therefore the Applicant asserts that all the claims are in a position for allowance.

Prior Art Made of Record and Not Relied Upon

The Applicant notes the prior art made of record but not relied upon and asserts that for the reasons set forth above, the claims are allowable over the art made of record.

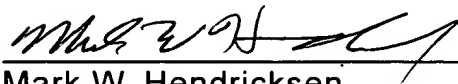
Conclusion

Applicant is submitting a Request for Continued Examination (RCE) herewith as well as any required fees.

Applicant therefore submits Claims 1-10 and 13-16 are in a position to proceed to allowance.

Respectfully submitted,

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